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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/634,469

08/05/2003

A. Colleen Schmidt

45,024

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28309

7590

07/21/2006

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EXAMINER

ROGERS, KRISTIN D

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,469

Applicant(s)

SCHMIDT, A. COLLEEN

Examiner

Kristin D. Rogers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 25, 2006 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 1 and 4-17 have been considered but are moot in view of the new ground(s) of rejection.
2. The Applicant argues that the Ogden reference does not disclose the "conduit" of the present invention. The Examiner disagrees. As broadly as structurally claimed the urine collection conduit of Ogden meets the claim language "...said conduit includes a first conduit end and a second conduit end, wherein the circumference of the first conduit end is smaller than the circumference of the second conduit end and, wherein said first conduit end extends from a first conduit opening and terminates at a shoulder, and said second conduit end extends from the shoulder and terminates at a second conduit opening, and wherein said second conduit end having a length that is substantially greater than the length of said first conduit end" recited by Applicant.

Claim Rejections - 35 USC § 112

3. Claims 1 and 4-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not teach the claimed limitation of the conduit 60 having the length of a second conduit end 60B substantially

greater than the length of first conduit end 60A. The Examiner believes that the Applicant is relying on the drawings, however the specification and the drawings are unclear regarding the dimensions of the first and second conduit end. Figures 1 and 2 are merely isometric illustrations of the invention claimed by applicant and lack clear indication of the lengths of the first and second conduit ends.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Propp (5919146) in view of Ogden et al. (6805690). In regard to claims **1 and 4-17**, Propp shows urine collection device 20 with bag including upper neck opening near element 64 and 66, lower neck opening near element 68, inner chamber or bag 56 and outlet 68 in fluid communication with chamber 56; an elongated tube 40 having an interior bore, having first end of tube 40 connected to the upper neck portion of the bag 56, and in fluid communication with inner chamber 56, a closure secured to outlet 68

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(column 3, lines 43-45). In regard to claims 4 and 10, Propp shows an aperture on the upper portion of bag 56 (Figure 1). In regard to claim 5, Propp shows the lower neck portion is disposed at the lowest gravitational area of the bag (Figure 1). In regard to claim 11, Propp shows a tube 40 with first end opening 66 connected at upper neck portion of bag 56 and second end 42 (Figure 1). In regard to claims 12 and 13, Propp shows a conduit 82 with bore extending the length of tube 40, first conduit end connected to second end 42, conduit 82 with second end to receive male penis, and wherein the first conduit opening is fixedly centered over the upper tube of the second end 42 of tube 40 (Figure 1). In regard to claims 6-8 and 14-16, Propp shows a bag 56 constructed of liquid impervious thermoplastic material that is flexible (column 3, lines 33-36 and 43-45). In regard to claim 17, Propp shows a method of collecting and discarding male urine comprising securing closure to an outlet 68 of urine collection device 20, device 20 comprising bag with inner chamber 56, upper neck portion of bag 56 shown in Figure 1, outlet 68 in fluid communication with bag chamber 56, flexible elongated tube 40 having bore in fluid communication with bag chamber 56, first end 66 connected to upper neck of bag 56, second end 42, tube 40 in fluid communication with inner chamber 56, conduit having bore 82, first conduit end connected to second end 42 of tube 40, and second conduit end, first conduit end having opening fixedly centered over upper tube opening of second end 42 of tube 40 (Figure 1) inserting male's penis in second end opening of conduit 82, second end of tube is elevated above first end allowing fluid flow by gravity (column 3, lines 33-36), collecting urine in bag chamber 56 of device 20, tilting bag 56, removing closure at outlet 68, and tilting bag 56. Propp

shows all of the claimed elements including a conduit with a first conduit end and a second conduit end attached to a tube 40 wherein the first conduit end is smaller in circumference than the second conduit end and wherein, the first conduit opening terminates at a shoulder (see Figure 1 element 82), but lacks disclosure of the lengths of the first and second conduit ends. Ogden et al. teaches a urine collection device for a male comprising a hollow conduit 50 having a bore extending the length of the tube with first conduit end 14 and opening 22 connected to tube 58 and second conduit end 12 and opening 26 for the purpose of insertion of male penis (Figure 4, column 2 lines 1-11). Ogden et al. further teaches the circumference of the first conduit end 14 is smaller than the circumference of the second conduit end 12 and, wherein said first conduit end extends from a first conduit opening and terminates at a shoulder 18,20, and 52, and said second conduit end 12 extends from the shoulder and terminates at a second conduit opening 26, and wherein said second conduit end having a length that is substantially greater than the length of said first conduit end (Figures 1,2 and 4). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Propp with a conduit having a second end having a length substantially greater than the length of the first conduit end as taught by Ogden et al. since such modification would provide a conduit for receiving the male penis that is resistant to breakage.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

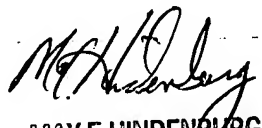
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin D. Rogers whose telephone number is 571.272.7293. The examiner can normally be reached on Monday through Friday 8:00am - 4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571.272.4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KDR


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